

No. 2996.

United States
Circuit Court of Appeals,
FOR THE NINTH CIRCUIT.

Wilson and Willard Manufacturing
Co.,

Appellant,

vs.

Union Tool Company, et al.,

Appellees.

Appellant's Reply to Appellees' Petition for Rehearing.

RAYMOND IVES BLAKESLEE,

Solicitor for Appellant.

FILED

APR 22 1916

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Appellant's Reply to Appellees' Petition for Rehearing.

In his petition the plaintiff-appellee does not agree with the opinion of this court that:

"The importance of this point is emphasized by the record which shows that Double cancelled his claim No. 8 and substituted claim No. 7, limited his specification and amended his claims to provide for opposite parallel bearing faces upon his hollow slotted extension."

We entertain no doubt that this court understands the elements of the Double device so thoroughly that no attempt to confuse these details will persuade it to

alter the sound opinion it has above expressed. A study of the file wrapper and contents of the Double patent on pages 227 to 264 of the book of exhibits in this case will show very clearly what was abandoned and what was sought to be claimed. The plaintiffs-appellees are plainly limited to the use of the opposite parallel bearing faces on their downward extension, and the exhibits referred to plainly show the effort the petitioner has made to cover these elements of his combination by the claims in his patent.

The object of this contention is to attempt to give his claims as broad a scope as his rejected claim 8 would have had. He is attempting to evade the limitation in his specifications and claims which prevents his opposite, parallel bearing faces from covering bearing faces which are not parallel. The opposite parallel bearing faces render impossible the gradual collapse of the slips which is necessary in order to avoid the evil known as "plunging" when the underreamer is used in hard ground, and this evil was eliminated by the use of the Wilson inclined bearing faces.

As much imagination would be required in order to believe that Wilson's inclined bearing faces were the equivalent of the opposite parallel bearing faces of Double as would be required to believe the argument on pages 12 and 13 of the petition which is intended to show that the faces 16 and 4^b of the Wilson cutters are the equivalents of the face 18 on the Double slips.

The next argument is intended to prove that the Double invention has the same mode of operation in its initial collapse as has the Wilson underreamer, and the opinion of the court is quoted as follows:

“The record shows that this operation causes what is called ‘plunging’ and which is obviated in the Wilson underreamer because of the fact that the cutters there collapse from the beginning of the downward movement.”

The plaintiff-appellee then attempts to deceive this court into believing that the “operation” referred to is the initial release or collapse of the slips *when the underreamer is to be withdrawn from the well*. This is not true. The “plunging” occurs during underreaming and not when the underreamer is being withdrawn from the well, and the evil of “plunging” is due to the slips resting on opposite, parallel bearing faces in the Double device. *Wilson eliminated this evil by so forming and adapting his lug element that the collapse of the cutters would begin with the first downward movement of the cutters*. With the Double no collapse can take place during the downward movement of the slips until said slips have moved the length of the opposite, parallel bearing faces. These parallel bearing faces produce the evil of “*plunging*” *while underreaming* and can never be used with a successful underreamer. They are positively a part of the Double combination and are included in his claims in the patent at bar. This court has rightly held that the Wilson lugs with inclined faces are not the equivalent of these opposite, parallel bearing faces on the Double downward extension, and this must be apparent when it is admitted that this Wilson feature eliminated this evil of “plunging” because the use of the Wilson lug with its inclined bearing face *gave the Wilson underreamer*

an entirely different mode of operation from that of the Double device. No argument will escape this fact.

The plaintiff-appellee has made a great effort to disguise this feature by arguments including open slipways, the tilting of the cutters, and the contracting of the cutters with the casing shoe, in an attempt to prove that Double is not limited in his claims to this method of the initial collapse of his cutters. This is only his manner of disguising a feature he greatly fears. Double's method of initiating the collapse of his slips is due to and depends entirely upon the use of opposite, parallel bearing faces, and as these are specifically claimed for this purpose in his claims he is limited to this mode of operation, which Wilson does not use. In this connection we will only say further that the importance of these opposite, parallel bearing faces to the Double invention is pointed out on pages 10 and 11 of petitioner's argument, as follows:

"The only other amendment to the Double specification was to insert the descriptive words 'with oppositely arranged parallel bearing facts' (faces). * * * The only addition to the specification or change in it *that can be claimed as a limitation* is the insertion which has just been quoted, and it is a true description of the intrust bearings which are formed at the lower end of the outward extensions. These intrust bearings are 'oppositely arranged parallel bearing faces.'"

(Like most of the citations and quotations in any brief of opposing counsel, the above quotation is in error, using the word "facts" where "faces" is used in the original text. In this instance we do not believe that the misquotation is intentional.)

The petitioner has again reverted to his favorite argument in regard to the so-called tilting of the Double slips when they collapse. The court correctly held that this tilting of the Double slips was due to the fact that the portion of the mandrel which acts to spread the slips apart when reaming, acts as a fulcrum for this tilting motion when the slips collapse. Also it was held that the Wilson cutters could not tilt in this manner as there is no portion of the spreading member between them during collapse to act as a fulcrum for this movement.

The plaintiffs-appellees say (page 9 of petition):

"In both the Double reamer and in the Wilson reamer the tilting action of the cutters is substantially identical,—if not absolutely identical. In neither is this tilting action in any manner due to the presence of any spreading member or downward extension between the cutters at the time of collapsion."

Mr. Double, the purported inventor of this device, does not agree with the petitioner, as will be seen from his testimony on page 963 of the record:

"My reamer had a tilting action, the cutters tilt on the key so as to allow the cutters to *close around the end of the underreamer so as to collapse.*"

We feel that the able decision of this court clearly shows that it has studied and fully understands the modes of operation of these devices and cannot be made to believe that the Wilson underreamer has a mode of operation even similar to that of the Double device. No argument will conceal the fact that the spreading member on the mandrel of the Wilson device is between the cutters when reaming and not between them when

collapsed; while the spreading member in the Double combination is between the slips at all times, and serves as a fulcrum for the expansion and collapshion of the slips. We are not afraid that the plaintiffs-appellees will be able to deceive this court with regard to these facts.

The plaintiffs-appellees charge this court with having failed to understand the Double device when it declared that the Double slips do not contain shanks, whereas, the Wilson cutters have cutter-heads and long shanks, but his only attempt to substantiate his statement is to say that this conclusion of the court "is shown to be a mechanical error by reference to the drawings of the Double patent or to any of the Double reamers."

Now this court will realize that most of the exhibits in this case are of Double infringements of the Wilson device and these infringements contain the Wilson cutter with cutter-head and a long shank. However, reference to the drawings of the Double patent in suit (Figs. X, XI and XII of patent book of exhibits, page 259) will show that in this device the cutter was not a cutter but a "slip" in the sense that it was without a shank as in the Swan underreamer, and was just as wide at the top as at the bottom, or cutting edge. The original Double reamer, which is the subject of this litigation, could not use a cutter with a shank and broad cutter-head because its mandrel did not have the Wilson lugs. As soon as the Wilson device appeared on the market the original Double reamer became instantly obsolete and Double sheared away its side-webs to form lugs, which permitted of the use of a cutter (as distinguished from a slip) with shanks and a broad

cutter-head. These are features of the Wilson invention and this court has correctly held them to be infringements of the Wilson patent.

We apprehend that this court will not wish us to argue any of the plaintiffs'-appellees' points at any length. The case has been carefully studied by Your Honors, as is evidenced by the detailed opinion you have rendered. We are confident that that opinion shows a knowledge of the details of these devices which cannot be confused by the statements of opposing counsel denying that certain most obvious results and forms of construction in these devices are what any honest person must concede them to be.

The reargument and rehearing of this case is asked for on the ground that this court has an erroneous impression of the mechanics of the devices in suit. No doubt this would give the opposing counsel another opportunity to attempt to confuse the court regarding these devices, but we have no fear in leaving this decision to this court as we are perfectly certain that anyone will be convinced that Your Honors' opinion in this case shows conclusively that you have thoroughly understood the underreamers in suit. All of the issues in this case have been thoroughly tried and this petition for a rehearing is, itself, the strongest argument that the plaintiffs-appellees in this case are unable to show any errors on the part of this court, and that their petition should, therefore, be dismissed.

Respectfully submitted,

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